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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,610	01/02/2002	Kristin Gallina Lovejoy	20070461	6001
25537 VERIZON PATENT MANAGEMENT GROUP 1515 N. COURTHOUSE ROAD SUITE 500 ARLINGTON, VA 22201-2909	7590 07/10/2008			
EXAMINER				
OYEBISI, OJO O				
ART UNIT		PAPER NUMBER		
3696				
NOTIFICATION DATE		DELIVERY MODE		
07/10/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

# Office Action Summary

**Application No.**

10/032,610

**Applicant(s)**

LOVEJOY ET AL.

**Examiner**

OJO O. OYEBISI

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC §101***

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).
4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.
5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims

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are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "means" recited in claims 9-16 appear to be directed to software. Meanwhile, the preamble of claims 9-16 are directed to "system," but the body of claims 9-16 do not recite any structural limitations that constitute the claimed system. It is not really clear to the examiner what the applicant is trying to claim. These rejections can be overcome by adding CPU in the claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 4, 9, 12, 17-19, 24, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (ABI hereinafter, Pub no.: **20020138416, please see the disclosed background of the invention**) in view of *Kalyan (US PAT: 6266655)*.

**Re claims 1, 9, 17 and 24.** ABI discloses a method for assessing and/or managing risks for an organization, comprising the steps of: (a) inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type, and wherein the electronic asset type includes computers and networking equipment therefor and the location asset type includes physical locations where the electronic asset types are placed (i.e., **Inventory and definition**). In order to measure the theoretical impact of a risk, the organization determines its assets (e.g., electronic devices, electronically stored data, etc.) that are involved in support of critical processes, see paras 0015 of the applicant's specification); (b) identifying at least one criterion defining a security objective of the organization (i.e., Vulnerability and threat assessment, see paras 0017); (c) identifying one or more inventoried assets that relate to the identified criterion (i.e., Once assets have been identified, a value is assigned to

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each asset, see paras 0015), and (e) assessing the risk to the organization based on the measured values of the one or more metric equations (i.e., Once risk has been assessed and identified, the organization can choose to accept the risk, mitigate the risk, or transfer the risk, see paras 0024). ABI does not explicitly disclose formulating one or more metric equations for each identified criterion, each metric equation being defined, in part, by the one or more identified assets, wherein each metric equation yields an outcome value when one or more measurements are made relating to the identified assets. However, Kalyan discloses the formulating and solving of equations for identified criteria (see the abstract, also see fig4 elements 43 and 44). Thus it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Kalyan into ABI to formulate and solve metric equations defining one or more assets of the organization since doing so would provide answers to business organizational questions in a more efficient and systematic way.

**Re claims 4, 12, 19, 27.** ABI further discloses the method, wherein the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group of users (i.e., e.g., electronic devices, electronically stored data, etc., see paras 0015).

**Re claim 18.** ABI further discloses the system , wherein the computer is further configured to: electronically scan the plurality of assets (i.e., There are a number of tools available to electronically scan electronic devices and assess vulnerabilities within electronic devices, see paras 0019); interview members of the organization to identify

the plurality of assets; and manually identify the plurality of assets (i.e., inventory and definition, paras 0015).

10. Claims **2, 3, 5-8,10, 11, 13-16, 20-23, 25-26, and 28-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over ABI in view of Kalyan as applied to claim 1 supra, further in view of Norton et al (Norton, hereinafter. Pub No.: 2002/0091699).

**Re claims 2, 10, 25.** ABI does not explicitly disclose the method wherein the step (a) comprises the step of: identifying the plurality of assets and storing the identified assets into a database. However, Norton makes this disclosure (i.e., standardized asset database, see fig. 1a, see also col.1 paras 0003). Thus, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Norton into ABI and Kalyan to effectively manage access to the asset information.

**Re claims 3, 11, 26.** ABI further discloses the method, wherein the step of identifying the plurality of assets comprises at least one of: electronically scanning the plurality of assets (i.e., There are a number of tools available to electronically scan electronic devices and assess vulnerabilities within electronic devices, see paras 0019); interviewing members of the organization to identify the plurality of assets; and manually identifying the plurality of assets (i.e., inventory and definition, paras 0015).

**Re claims 5-8, 13-16, 20-23, 28-31.** ABI does not explicitly disclose the method, further comprising the step of: establishing at least one relationship between the plurality of assets. However, Norton makes this disclosure (see fig.8, also see col.4 paras 0085-0090). Thus, it would have been obvious to one of ordinary skill in the art to incorporate

the teachings of Norton into ABI and Kalyan to effectively manage access to the asset information.

### ***Response to Arguments***

The applicant argues in substance that the primary reference, ABI, fails to teach "a location asset type that includes the physical location of an electronic asset." Contrary to the applicant's assertion, ABI teaches "In order to measure the theoretical impact of a risk, the organization determines its assets (e.g., electronic devices, electronically stored data, etc.) that are involved in support of critical processes, see paras 0015 of the applicant's specification." Thus the examiner contends that the assets that are determined by the organization encompass all asset types. Further, Paragraph 0015 of applicant's background of the invention clearly states that the organization determines its assets which obviously include location and electronic asset types.

The applicant further argues that ABI fails to disclose identifying at least one criterion defining a security objective of the organization. Contrary to the applicant's assertion, ABI teaches Vulnerability and threat assessment, see paras 0017 of applicant's background of the invention. The examiner contends that Vulnerability and threat assessment are criteria defining a security objective of the organization.

The applicant further argues that ABI fails to teach identifying one or more inventoried assets that relate to the identified criterion. Contrary to applicant's assertion, ABI teaches identifying assets and assigning a value to each asset, see paras 0015 of applicant's background of the invention.

The applicant further argues that ABI fails to teach assessing the risk to the



organization based on the measured values of the one or more metric equations.

Contrary to the applicant's assertion, ABI teaches identifying and assessing the risk of the organization, see paras 0024 of applicant's background of the invention.

The applicant further argues that, the secondary reference, Kalyan fails to disclose "formulating one or more metric equations for each identified criterion."

Contrary to the applicant's assertion, Kalyan discloses a method of valuing resources of an asset intensive manufacturer by setting up equations and solving each equation for the resource variables (see the abstract, also see fig.4 elements 43 and 44). The examiner contends that since identified criterion, as claimed by the applicant, is a measured variable, and since Kalyan teaches setting up and solving equations for measured variable (i.e., resources of an asset intensive manufacturer), Kalyan teaching certainly meets the applicant's claimed limitation of "formulating one or more metric equations for each identified criterion."

The applicant further argues that, the secondary reference, Norton fails to disclose "establishing at least one relationship between the pluralities of assets."

Contrary to the applicant's assertion, Norton explicitly discloses "establishing at least one relationship between the pluralities of assets." (i.e., fig. 8 of Norton clearly shows at least one relationship between the pluralities of assets, please see fig.8 of Norton).

The applicant further argues that Norton fails to disclose "linking a first asset defined to be in one asset type with a second asset defined to be in another asset type." Contrary to the applicant's assertion, Fig.1a of Norton discloses a standardized asset database, wherein different asset types are inherently linked together.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

/O. O. O./

**Application Number****Application/Control No.**

10/032,610

**Applicant(s)/Patent under  
Reexamination**

LOVEJOY ET AL.

**Examiner**

OJO O. OYEBISI

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